

REMARKS

The above-captioned application has been amended so as not to claim priority from European Patent Application publication no. EP 0 974 357 A1.

Claims 21-36 and 69 are pending in this application. Claims 21-36 and 69 stand rejected. Claim 25 has been canceled. Claims 21, 26, 27, 29, 31, 33 and 35 have been amended.

This amendment and response has been prepared according to the USPTO's revised amendment format.

Priority

Applicants' claim for priority to European Patent Application publication no. EP 0 974 357 A1 under 35 U.S.C. § 119 (a)-(d) was denied as having been filed more than twelve months after the filing date of the foreign application. In response, applicants have deleted page 1, lines 5-6 of the specification.

Rejections under 35 U.S.C. § 102

Claims 21-36 and 69 stand rejected under 35 U.S.C. § 102(a) as being anticipated by European Patent Application publication no. EP 0 974 357 A1 ("the '357 application"). Specifically, the Examiner stated that the '357 application teaches all of the elements of the pending claims.

The '357 application refers generally to the use of chemokines to modulate immune responses. The disclosure is specifically directed to the chemokines MIP-3 α and MIP-3 β . The '357 application lists five inventors: Christophe Caux, Beatrice Vanbervliet, Serge Lebecque, Alain P. Vicari and Marie-Caroline Dieu.

The present application was filed in the name of three inventors: Alain P. Vicari, Christophe Caux and Drake LaFace. Independent claim 21 of the present application has been amended and is now directed to a method for enhancing an immune response in a mammal comprising administering an antigen and a chemokine to the mammal, wherein the chemokine is MCP-4 or a biologically active fraction of MCP-4. Support for the amendment to claim 21 can be found in original claim 25; page 5, lines 29-31; page 6, lines 16-19; from page 9, line 27 to page 10, line 22; and elsewhere in the specification. Therefore no new matter has been added.

Applicants are filing concurrently herewith an Amendment and Request to Correct Inventorship under 37 C.F.R. § 1.48(b) in order to delete Drake LaFace as an inventor of the above-identified application. This is necessary because the amendment that was filed February 28, 2002 in response to the Office Action dated January 11, 2002 resulted in the cancellation of claims so that Drake LaFace's invention is no longer being claimed in the above-identified application.

In light of the correction of inventorship, the enclosed Declarations under 37 C.F.R. § 1.132 of inventors Vicari and Caux, and the following remarks, applicants respectfully request withdrawal of the 102(a) rejection in light of the '357 application.

As evidenced by the accompanying Declarations, the subject matter relating to MCP-4 in both the '357 application and the present application was invented by Christophe Caux and Alain P. Vicari. The MCP-4 invention was disclosed to Beatrice Vanbervliet, Serge Lebecque and Marie-Caroline Dieu, inventors of the '357 application, by Alain P. Vicari and Christophe Caux while all five were working in the Laboratory for Immunological Research of Schering-Plough (France), a subsidiary of Schering-Plough Corporation. This same subject matter was also disclosed to Drake LaFace, a named inventor of the present application, by Alain P. Vicari and Christophe Caux while all three were collaborating on the

present application. Drake LaFace works for Canji Incorporated, a subsidiary of Schering-Plough Corporation, located in San Diego, California. Accordingly, it is applicants' position that the '357 application describes applicants' own work and does not constitute prior art against the pending claims. M.P.E.P. § 715.01. Accordingly, the '357 application does not anticipate applicants' claims.

Neither does the '357 application render obvious applicants' claims. The disclosure of the '357 application that is available as a reference under 35 U.S.C. § 102(a) against applicants' invention is directed to MIP-3 α and MIP-3 β . One of skill in the art would not be motivated to modify the disclosure to arrive at applicants' invention, which is directed to the use of MCP-4 and an antigen.

Claims 21-23, 35, 36 and 69 stand rejected under 35 U.S.C. § 102(b) as being anticipated by PCT international publication no. WO 98/14573 ("Luster"). Specifically, the Examiner stated that Luster teaches the administration of human MCP-4 in the form of a protein or a nucleic acid vector in order to stimulate immune responses in mammals. Applicants respectfully traverse the above rejection and request reconsideration of claims 21-23, 35, 36 and 69, as amended.

Luster relates to MCP-4 polypeptides, nucleic acids encoding the polypeptides, and uses of the polypeptides.

Independent claim 21, and the claims that depend therefrom, has been amended to recite a method for enhancing an immune response in a mammal comprising administering an antigen and a chemokine to the mammal, wherein the chemokine is MCP-4 or a biologically active fraction of MCP-4. Luster does not disclose the administration of the combination of an antigen and chemokine (MCP-4) in order to alter the immune response in a mammal. Therefore, applicants submit that the claims, as amended, are novel in light of Luster.

Moreover, there is no suggestion in Luster that MCP-4 be administered in combination with an antigen. Accordingly, withdrawal of the rejection of claims 21-23, 35, 36 and 69 under 35 U.S.C. § 102(b) in view of Luster is respectfully requested.

Rejection under 35 U.S.C. § 112, second paragraph

Claims 35 and 69 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner stated that the term "activating agent" is confusing as it is unclear what substance or effect the agent is intended to activate.

In order to expedite prosecution of the instant application, applicants have amended claim 35. Claim 69 depends from claim 35. As amended, claim 35 has been amended to recite "a dendritic cell" before the term "activating agent." Applicants believe the amended claims address the Examiner's concerns as they now recite what substance or effect the agent is intended to activate.

Applicants submit that claims 35 and 69, as amended, satisfy the requirements of 35 U.S.C. § 112, second paragraph. Support for the amended claims can be found on page 6, lines 7-10 and elsewhere in the specification. Therefore no new matter has been added. Accordingly, withdrawal of the rejection under 35 U.S.C. § 112, second paragraph is respectfully requested.

CONCLUSION

Applicants submit that the claims are definite. In addition, applicants submit that the cited references do not constitute prior art against the claims and do not either disclose or suggest the claimed method. Accordingly, reconsideration of the rejections and allowance of the claims at an early date are earnestly solicited.

If the undersigned can be of assistance to the Examiner in addressing issues to advance the application to allowance, please contact the undersigned at the number set forth below.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Michael Biro".

Michael G. Biro
Reg. No. 46,556

Schering-Plough Corporation
Patent Department
Mail Stop K-6-1, 1990
2000 Galloping Hill Road
Kenilworth, NJ 07033-0530

Phone: (908) 298-5098
Fax: (908) 298-5388